

Remarks

Claims 3-14, 17, 18 and 22-28 were pending in the subject application. By this Amendment, Applicants have amended claims 3, 10, 17, 18 and 23 by narrowing the either or both of the definitions for the variables R3 and n. Applicants respectively submit that the amendments to the claims are fully supported by the description and that no new matter has been added. Accordingly, upon entry of this Amendment, claims 3, 10, 17, 18 and 23, as amended, and claims 4-9, 11-14, 22, and 24-28 will be pending and under examination.

I. Claim Rejection – 35 USC 102(a)

On page 2 of the Office Communication, the Examiner rejected claims 3 and 4 under 35 USC 102(a) as being inherently anticipated by Salon, et al. WO 2002002744. The Examiner asserted that when Salon et al. teaches compounds wherein each A is H, Z is carbonyl, n is 1, R4 is phenyl, and R2 is alkyl, a compound of the instant claims is produced.

In response, Applicants have amended claim 3 as well as claims 10, 17 and 18 by narrowing the definition of the variable n to be an integer from 2 to 6 inclusive. By amending claims 3, 17 and 18, Applicants have excluded the inherently anticipatory intermediates (piperidiny1-benzamide moiety) of the compounds of examples 60, 61, 68, 75, 76, 79, 80 and 83 of WO 2002002744 from the scope of the pending claims. Accordingly, Applicants maintain that pending claims 3 and 4 as well as claims 10, 17 and 18 are not anticipated by the inherent disclosure of WO 2002002744 and respectively request that the Examiner reconsider and withdraw this ground of rejection.

II. Claim Rejection – 35 USC 112, 1st paragraph

The Examiner rejected claims 3, 17, 18 and 26-28 under 35 USC 112, first paragraph by asserting that the specification does not reasonably provide enablement for the full scope of compounds bearing the extensive list of substituents. The Examiner suggested that the variable, R3, should be limited to phenyl (in the definition of R4).

In response, and in an attempt to advance the prosecution of the subject application but without conceding the correctness of the Examiner's position, Applicants have amended claims 3, 17, 18 and 23 by limiting the definition of R3 in each of these claims to phenyl, optionally substituted. Accordingly, Applicants maintain that pending claims 3-8, 17, 18, 23, 27 and 28 are now fully enabled by the specification and respectively request that the Examiner reconsider and withdraw this ground of rejection.

III. Double Patenting

On page 8 of the Office Action, the Examiner provisionally rejected claims 3-14, 17, 18 and 22-28 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of co-pending U.S. Application No. 11/034,611. The Examiner asserted that although the conflicting claims are not identical, they are not patentably distinct from each other because they cover the same compounds.

In response, and upon the indication of allowable subject matter, Applicants will consider filing a terminal disclaimer to overcome the obviousness-type double patenting rejection.

Conclusion

In view of the above remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue. No fee is deemed necessary with the filing of this Amendment. However, if any additional fee(s) is required, authorization is hereby given to charge such fee(s) to Deposit Account No. 503201.

Respectfully submitted,

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